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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,963	03/27/2007	Yoshiyuki Futagami	050841	3196
23850 7590 07/08/2009 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W.			EXAMINER	
			TRIEU, THERESA	
Suite 400 WASHINGTO	N, DC 20005		ART UNIT	PAPER NUMBER
			3748	
			MAIL DATE	DELIVERY MODE
			07/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)		
	10/561,963	FUTAGAMI ET AL.		
Office Action Summary	Examiner	Art Unit		
	Theresa Trieu	3748		
The MAILING DATE of this communication appeariod for Reply	pears on the cover sheet with the c	orrespondence address		
A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING D - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 136(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from e, cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).		
Status				
 Responsive to communication(s) filed on 11 J This action is FINAL. 2b) This Since this application is in condition for allowated closed in accordance with the practice under the 	s action is non-final. nce except for formal matters, pro			
Disposition of Claims				
4) ☐ Claim(s) 9-12 is/are pending in the application 4a) Of the above claim(s) is/are withdra 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 9-12 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/o Application Papers 9) ☐ The specification is objected to by the Examine 10) ☐ The drawing(s) filed on is/are: a) ☐ accomplicant may not request that any objection to the	wn from consideration. or election requirement. er. cepted or b) □ objected to by the I			
Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the E:	• • • • • • • • • • • • • • • • • • • •	• ,		
Priority under 35 U.S.C. § 119		, tollow or 10 mm 1 7 o 10 2 i		
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.				
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date May 20, 2009.	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	nte		

DETAILED ACTION

This Office Action is responsive to the applicants' RCE filed on June 11, 2009.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 11, 2009 has been entered.

Claims 1-8 have been canceled. Claims 9 and 11 have been amended. Accordingly, claims 9-12 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said sliding portion" in page 3, line 5. Claim 11 recites the limitation "said sliding portion" in page 4, line 8. There are insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. Claims 9, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of Takei (Publication Number JP 63-289280) and further in view of Yamada et al. (Yamada) (Patent Number 5,468,130).

Regarding claims 9 and 11, APA discloses a scroll compressor in which a scroll fixed lap 2a rising from a fixed plate 2b of a fixed scroll 2 and a scroll orbiting lap 4a rising from an orbiting plate 4b of an orbiting scroll are combined with each other to form compression chambers therebetween, a plate back surface of the orbiting scroll is provided with a back pressure space 8a, the back pressure space is divided into an inner region and an outer region by a seal ring 14, high pressure is applied to the inner region of the seal ring, pressure which is lower than that applied to the inner region is applied to the outer region, thereby bringing the orbiting scroll into contact with the fixed scroll, a rotation-resistant part 22 restrains the orbiting scroll from rotating, the orbiting scroll is allowed to orbit, thereby moving the compression chamber toward a center of scroll while reducing volume of the compression chamber, refrigerant gas is sucked into the compression chamber and compressed, wherein the fixed scroll is made of iron-based material, the orbiting scroll is made of aluminum-based material. However, APA fails to disclose only the plate back surface of the orbiting scroll being subjected to surface processing.

Regarding claims 9 and 11, Takei teaches that it is conventional in the art to utilize only the plate back surface of the orbiting scroll 18 is subjected to surface processing to form a hardened layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized only the plate surface of the orbiting being subjected to surface processing, as taught by Takei in the APA apparatus, since the use thereof would have

reduced the wear amount, provided an abrasion resistance with high load and obtained a lightweight captioned machinery

Regarding claims 9 and 11, the modified APA discloses the invention as recited above; however, the modified APA fails to disclose a sliding portion between the plate back surface and the seal ring being masked and subjected to the surface processing; a sliding portion between the plate back surface and the seal ring being removed by working. A product-by-process limitation and the determination of patentability in a product-by-process claim are based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695,697,227 USPQ 964,966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Regarding claims 10 and 12, Yamada further disclose nickel phosphorus plating processing being carried out as the surface processing (col.4, lines 24-37 – col. 5, lines 2-14).

Prior Art

4. The IDS (PTO-1449) filed on June 11, 2009 has been considered. An initialized copy is attached hereto.

Conclusion

5. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F.R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without

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specifically pointing out how the language of the claims patentably distinguishes them from the

references does not comply with the requirements of this section. Moreover, "The prompt

development of a clear Issue requires that the replies of the applicant meet the objections to and

rejections of the claims." Applicant should also specifically point out the support for any

amendments made to the disclosure. See MPEP §2163.06 II(A), MPEP §2163.06 and MPEP

§714.02. The "disclosure" includes the claims, the specification and the drawings.

Communication

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The

examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Theresa Trieu/

Primary Examiner, Art Unit 3748

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